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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,289	07/23/2003	Abel G. Pereira	CRODA 3.0-013 CIP	7905

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EXAMINER

HARDEE, JOHN R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,289

Applicant(s)

PEREIRA ET AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 10-16 and 23-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 10-16, and 23-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 3-7, 10-16, and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60-81376. The reference discloses fabric treating compositions comprising perfume and ingredients A-D, of which A may be an imidazolinium compound of the form shown at the bottom of p. 2, col. 1. R1 and R2 are alkyl or alkenyl of 10-24 carbons, R3 is alkyl or hydroxyalkyl of 1-3 carbons (p. 2, col. 2, lines 20+), and X can be any salt forming counterion, including halogen and methyl sulfate. While mixtures of compounds having the ratios of chain lengths recited by applicant are not disclosed, use of compositions with R groups derived from beef tallow is exemplified, so the definition of the R groups clearly embraces mixtures of chain lengths. Applicant has noted that beef tallow comprises approximately 60% of C-18 chains. As this is the next lower homolog of C-19, similar results would be expected with C-19, absent any showing of unexpected results. Furthermore, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi* 169 USPQ 423. When ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same

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fashion as the individual materials, absent unexpected results. Ingredients A+B are present at 10-95% of the compositions, more preferably 50-90% by weight, and $B/(A+B)$ is 0.5%-40% of the composition as a whole. The imidazoliniums are insoluble in water and therefore act as film formers. The compositions preferably comprise hydrocarbon waxes or higher alcohols, both of which are film formers, being insoluble in water. Additional surfactants are disclosed as being present, with an ethoxylated alkyl phenol, a nonionic surfactant, being present in Example 2. The compositions are formed by making a co-melt of ingredients A-D. Addition of water is not disclosed. Claims drawn to personal care compositions recite intended use and are not afforded additional patentable weight. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

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3. Claims 3-7, 10-16, and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 58-144174 A. The reference discloses textile or hair treating compositions comprising perfume and an imidazolinium compound of the form shown at the bottom of p. 2, col. 1. R5 and R6 are alkyl or alkenyl of 12-24 carbons, R7 is alkyl or hydroxyalkyl of 1-3 carbons (p. 2, col. 2, lines 20+), and Z can be any salt forming counterion. Compositions may further comprise either or both of quats II and III, which are insoluble in water, and therefore film formers. Ingredients A and B are added to aqueous textile softeners or hair rinses at 0.1-20% by weight. Additional cationics are present. While mixtures of compounds having the ratios of chain lengths recited by applicant are not disclosed, the examiner notes that it is notoriously common in the surfactant art to use feedstocks derived from natural fats, in which a mixture of chain lengths would present. Furthermore, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi* 169 USPQ 423. When ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results.

4. Claims 3-7, 10-16, and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnabas et al., US 5,721,205. The reference discloses rinse-added fabric softening compositions comprising nonionic softener (a) and cationic softeners (b)

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and (c) (col. 6, lines 1+). These are preferably present at about 10-80%; 3-40%; and 10-80% respectively. Component (c) may be the imidazolinium species depicted at col. 10, line 60, in which R1 is a hydrocarbon group of 15-21 carbons, R2 is an alkylene group of 1-3 carbons; and R5 is saturated alkyl or hydroxyalkyl of 1-4 carbons. The counterion may be chloride, bromide, methylsulfate or other species (col. 13, lines 45+). Compositions preferably comprise a liquid carrier which is mostly water (col. 19, lines 35+). The compositions comprise a radical-scavenging antioxidant, which may be a natural tocopherol, also known as vitamin E (col. 14, line 22). While mixtures of compounds having the ratios of chain lengths recited by applicant are not disclosed, the examiner notes that it is notoriously common in the surfactant art to use feedstocks derived from natural fats, in which a mixture of chain lengths would present.

Furthermore, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi* 169 USPQ 423. When ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

Response to Arguments

5. Applicant's amendments overcome the 112 and 102 rejections.
6. Applicant's arguments filed July 14, 2005 have been fully considered but they are not persuasive. Applicant argues that the chain lengths as currently claimed do not read on beef tallow. This is correct, but it is not persuasive because C-19 is a one-carbon homolog of C-18, which comprises, according to applicant, about 60% of C18 species. An adjacent homolog would be expected to have similar properties to those of the disclosed species. Regarding longer chain lengths, these are made obvious over the general disclosure in the JP 60 of the utility of species of up to 24 carbons. In the absence of any showing of unexpected results, the rejection is maintained.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee". The signature is fluid and cursive, with the first name "John" and last name "Hardee" clearly distinguishable.

John R. Hardee
Primary Examiner
August 2, 2005